REMARKS

Reconsideration of the Office Action mailed June 22, 2004, (hereinafter "instant Office Action"), and withdrawal of the rejection of claims 1-22 and 38-58, are respectfully requested.

In the instant Office Action, claims 1-60 are listed as pending, claims 23-37, 59 and 60 are listed as withdrawn from consideration and claims 1-22 and 38-58 are listed as rejected. The Examiner has made the Election/Restriction requirement final.

The Examiner has rejected claims 1-22 and 38-58 under 35 U.S.C. §102(a,b) as allegedly being anticipated by (1) Duncia et al., U.S. 6,214,851, see CAS: 133:252423; (2) Sawhney et al., Indian Journal of Chemistry, Section B: Organic Chemistry Including Medicinal Chemistry (1983), 22B(10), 1044-9, see CAS:100:139014; (3) Bhattacharya et al., Wear (1990), 136(2), 345-57, see CAS:113:100536. Applicants respectfully traverse this rejection.

With respect to the rejection of claims 1-22 and 38-58 under 35 U.S.C. §102(a,b) as allegedly being anticipated by (1) Duncia et al., U.S. 6,214,851, see CAS: 133:252423, the Examiner states:

> Duncia et al. disclose a compound Urea, N-(4-chloro-2-benzothiazolyl)-N'-tricyclo[3.3.1.13,7]dec-1-yl-, clearly anticipate the instant compound of formula (I), wherein the variable R^1 represents hydrogen; the variable R^2 represents halogen (i.e., Cl); the variables W and Q independently represents hydrogen; the variable Y represents O; the variable X^1 represents hydrogen; the variable R^3 represents cycloalkyl, see RN:295787-87-0 of CAS:133:252423.

The compound having the RN number 295787-87-0 does not anticipate claims 1-22 and 38-58 because of the proviso in claim 1 which reads "when Q is H; Y is O; R^1 and R^2 are each hydrogen, halogen, alkyl, alkoxy, alkylthio, carboxyalkyl or optionally substituted phenyl; and X^1 is hydrogen or alkyl; then R^3 is not alkyl, alkenyl, alkoxy, cycloalkyl or optionally substituted phenyl" (emphasis added). In the compound having the RN number 295787-87-0, Q is H; Y is O; R^1 is H and R^2 is Cl; X^1 is H and R^3 is cycloalkyl.

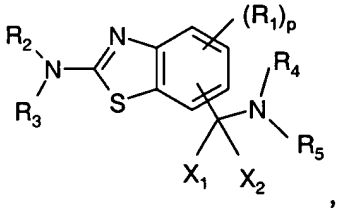
With respect to the rejection of claims 1-22 and 38-58 under 35 U.S.C. §102(a,b) as allegedly being anticipated by (2) Sawhney et al., Indian Journal of Chemistry, Section B: Organic Chemistry Including Medicinal Chemistry (1983), 22B(10), 1044-9, see

CAS:100:139014, Applicants have amended claim 1 to exclude the compound having RN number 52112-82-0.

With respect to the rejection of claims 1-22 and 38-58 under 35 U.S.C. §102(a,b) as allegedly being anticipated by (3) Bhattacharya et al., Wear (1990), 136(2), 345-57, see CAS:113:100536, Applicants have amended claim 1 to exclude the compound having RN number 52112-81-9. Within the full publication of Bhattacharya et al., compounds similar to RN 52112-81-9 are described wherein H, Cl or OCH_3 can also be present at the "W" position. Claim 1 has also been amended to exclude these compounds.

Based upon the foregoing, the rejection of 1-22 and 38-58 under 35 U.S.C. §102(a,b) as allegedly being anticipated by (1) Duncia et al., U.S. 6,214,851, see CAS: 133:252423; (2) Sawhney et al., Indian Journal of Chemistry, Section B: Organic Chemistry Including Medicinal Chemistry (1983), 22B(10), 1044-9, see CAS:100:139014; (3) Bhattacharya et al., publication, Wear (1990), 136(2), 345-57, see CAS:113:100536 is obviated and should be withdrawn.

The Examiner has rejected claims 1-22 and 38-58 under 35 U.S.C. §103(a) over Das et al., U.S. 2002/0123484 A1. The Examiner states:

> Das et al. disclose a compound of formula (I) as protein kinase inhibitors,
>
> 
>
> , wherein the variable R_1, R_2, R_4 and R_5 independently represents hydrogen, halo, cyano, nitro, alkyl, $-C(O)_qR_6$, and R_6 represents alkyl; and the variable p is 0 or 1; the variable X_1 and X_2 independently represent hydrogen; the variable R_3 represents $-Z_{13}-NR_7R_8$, and Z_{13} represent $-Z_{11}-C(S)-Z_{12}$, Z_{11} and Z_{12} independently represent a bond, R_7 and R_8 independently represent hydrogen, alkyl, alkenyl, alkynyl, cycloalkyl, or $-C(O)_qR_6$, and R_6 represents alkyl, the variable q is 1 or 2; see columns 18-19.

The Examiner alleges that the difference between the instant claims and Das et al. is that the instant variably Y represents O or S, while Das et al. represents S at the same position. Applicants respectfully traverse this rejection.

The Examiner points to the examples in columns 14-17 of Das et al. Applicants' genus has the moiety $-N(Q)-C(=Y)-N(X^1)-R^3$ attached to the 2-position of the benzothiazole. Examples 1, 9, 10 and 11 of Das et al. have an oxygen between the carbonyl and R^3. Examples 2,

3, 5 and 6 of Das et al. have a carbon at this position. Example 4 has a phenyl at this position. None of these examples teach, suggest or make obvious Applicants' genus. Applicants have amended claim 1 to exclude examples 7 and 8 from Das et al., U.S. 2002/0123484 A1.

With respect to motivation or suggestion within the reference itself to modify the reference so that it would encompass Applicants' invention, The Examiner states on page 8 of the instant Office Action that:

> One having ordinary skill in the art would find the claims prima facie obvious because one would be motivated to employ the compounds of Das et al. to obtain a compound of formula (1), wherein the variable Q represents hydrogen thereof; the variable Y represents S; the variable W represent H, Cl, NO_2, substituted alkyl, etc; the variable X_2 represent hydrogen or alkyl; the variables R_1, R_2, and R_3 independently represent hydrogen, alkyl, nitro, amino, NHX_2 or NX_3X_3, and X_2 is hydrogen, alkyl or aryl.
>
> The motivation to make the claimed compounds derives from the expectation that he instant claimed compounds derived from know Das et al. compounds would possess similar activity (i.e., protein kinase inhibitors) to that which is claimed in the reference.

No such motivation or suggestion exists in Das et al. Das et al. does not envisage anything other than oxygen at the position of Applicants' Y group. Whether the prior art provides the suggestion or motivation or teaching to select from prior knowledge and combine it in a way that would produce the invention at issue is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Applicants' genus always has the moiety –N(Q)-C(=Y)-$N(X^1)$-R^3 attached to the 2-position of the benzothiazolyl. The Examiner points to the examples in columns 14-17 in Das et al.. Examples 1, 9, 10 and 11 of Das et al. have an oxygen between the –C(=Y) and R^3, whereas Applicants' genus has $N(X^1)$. Examples 2, 3, 5 and 6 of Das et al. have a carbon at this position; example 4 has a phenyl at this position. When the prior art fails to suggest the claimed invention as a whole, as it does here, any reconstruction of the prior art to obtain that invention necessarily and inevitably requires impermissible hindsight.

An invention is to be considered as a whole. The claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered as a whole. See, e.g. W.L. Gore & Assoc. Inc. v. Garlock, Inc. 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983)); Jones v. Hardy, 727 f.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1983). However,

the Examiner has dissected the invention into separate elements and analyzed each one individually, when such is not presented by Applicants, without considering the genus as a whole, by selectively choosing moieties to create a subgenus which is not disclosed in Das et al. to compare with the instant application. In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp.,713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). The Examiner has not shown how Das et al. render obvious the entire genus of Applicants' claim.

Applicant points out that the Court of Appeals, Federal Circuit stated in In re Grabiak that "there must be adequate support in the prior art for the ester/thioester change in structure, in order to complete the PTO's prima facie case and shift the burden of going forward to the applicant." In re Grabiak, 226 USPQ 870, 872, 1985.

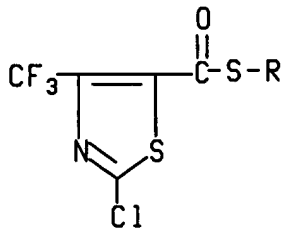
The Grabiak court further cited the following passage from In re Bergel, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961), in support of their ruling:

> The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contain something to suggest the desirability of the proposed combination.

In re Grabiak, 226 USPQ 870, 872.

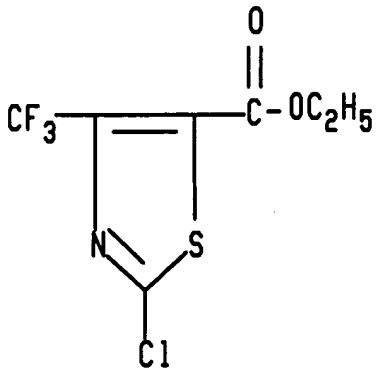
The Grabiak court made the above statement in light of the fact that both appellant's compounds and the prior art compounds were very similar in structure (see below) and had the same utility, namely, as herbicidal safeners.

Grabiak's Compound:



wherein R is C_{1-5}alkyl, phenyl or benzyl

Howe's Compound:



Note that when the R substituent is ethyl in the Grabiak compound, that the only difference in structure between Grabiak and Howe is a single atom, namely, an oxygen atom versus a sulfur atom. Hence, structural similarity and identical utility on its own cannot be the sole basis for a rejection under 35 U.S.C. § 103. Yet, the Examiner's rejection in the instant application under 35 U.S.C. § 103 does just that. The rejection is based solely upon structural and use similarity between the instant application and Das et al. without any suggestion from said reference, which is in direct contravention to well-established decisions of the Court of Appeals for the Federal Circuit.

Based upon the foregoing, the rejection of claims 1-22 and 38-58 under 35 U.S.C. §103(a) over Das et al. is obviated and should be withdrawn.

No fees are due for the instant amendment since the total number of claims after entry of the amendments hereinabove is not more than the total number of claims that Applicants have paid for to date.

Based upon the foregoing, Applicants believe that claims 1-22 and 38-58 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that there are any issues that could be resolved in a telephone conference, Applicants invite the Examiner to call Applicants' undersigned agent.

Respectfully submitted,

Date: September 22, 2004

Gayle O'Brien

Gayle O'Brien
Agent for Applicants
Reg. No. 48,812

Abbott Bioresearch Center, Inc.
100 Research Drive
Worcester, MA 01605
(508) 688-8053